



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/699,765 | 10/30/2000 | Rene Lattmann | 4-20918B/N1 | 7049 |

1095 7590 02/05/2002

THOMAS HOXIE
NOVARTIS CORPORATION
PATENT AND TRADEMARK DEPT
564 MORRIS AVENUE
SUMMIT, NJ 079011027

EXAMINER

MORRIS, PATRICIA L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1625

DATE MAILED: 02/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/699,765

Applicant(s)
Keri et al.

Examiner
Patricia L. Morris

Art Unit
1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 6, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) 1-4, 11, and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☒ Claim(s) 8-10, 12, and 13 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1625

DETAILED ACTION

Claims 5-10 , 12 and 13 are under consideration in this application.

Claims 1-4, 11 and 14 are held withdrawn from consideration as being drawn to nonelected subject matter.

Election/Restriction

Applicant's election with traverse of Group I and example 5 in Paper No. 7, filed December 6, 2001 is acknowledged. The traversal is on the grounds that the inventions are not patentably distinct. This is not found persuasive for the reasons clearly set forth in Paper no. 5. Applicants' own claims demonstrate that the inventions are patentably distinct because the claims differ in scope. The compounds in Group I are well known in the prior art. Further, applicants' own proviso clause destroys any unity of invention.

The restriction requirement is deemed sound and proper and is hereby maintained.

The application has been examined with regard to the elected compound wherein R₃, R₆ and R₇ represent non-heterocyclic groups, exclusively. The additional heterocycles pertain to nonelected subject matter. It is suggested that the nonelected compounds be deleted.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

Art Unit: 1625

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The expressions “substituted” and “protective group” in claims 5-7 are employed with considerable abandon throughout the claims with no indication given as to what the substituents and protective groups really are.

One should be able, from a reading of the claims, determine what that claim does or does not encompass.

Why? Because that claim precludes others from making, using, or selling that compound for 20 years. Therefore, one must know what compound is being claimed.

The written description is considered inadequate here in the specification. Conception of the intended substituents and protective groups should not be the role of the reader. Applicant should, in return for a 20 year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35 USC 112, first and second paragraph. If you (the public) find that it works, I claim it, is not a proper basis of patentability. In re Kirk, 153 USPQ 48, at page 53.

The claims measure the invention. United Carbon Co. V. Binney & Smith Co., 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

Art Unit: 1625

The U.S. Court of Claims held to this standard in *Lockheed Aircraft Corp. v. United States*, 193 USPQ 449, "Claims measure invention and resolution of invention must be based on what is claimed".

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": *In re Priest*, 199 USPQ 11, at 15.

Allowable Subject Matter

Claims 9, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 8 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the elected compounds.

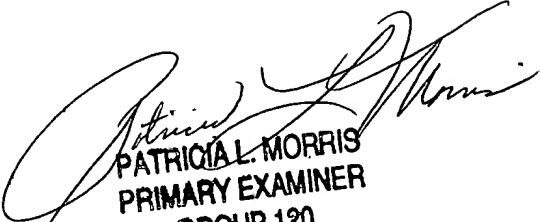
Claim 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and limiting the claim to the subject matter indicated as being examinable, supra.

Art Unit: 1625

Claims 6 and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and rewritten directed solely to the elected compounds

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.


PATRICIA L. MORRIS
PRIMARY EXAMINER
GROUP 120

plm

February 1, 2002